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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,582	06/28/2001	Roger Y. Kim	ART-002	6599
7590 05/06/2005				
FLESHNER & KIM, LLP				
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Chantilly, VA 20153-1200				
EXAMINER				
FISH, JAMIESON W				
ART UNIT		PAPER NUMBER		
2616				

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,582

Applicant(s)

KIM ET AL.

Examiner

Jamieson W. Fish

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

2. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1-20 of copending Application No. 09/795775. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Specification

4. The disclosure is objected to because of the following informalities: Page 6 Descriptions of the Figure 6 and 7 need to be added. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Payton et al. (U.S. Patent No. 5,790,935).

7. Referring to claim 1, Payton discloses receiving a plurality of audio-video data files on at least one remote memory device (see central distribution server 24 in Figure 2 and Column 4, Lines 45-46) from at least one data repository (see Column 4, Lines 55-57 and Figure 2 for the digital repository 34).

8. Payton also discloses automatically selecting a plurality of groups of files from the plurality of audio-video files (see Column 5, Lines 6-21 for the developing a user profile based on what programs the user has selected and rated) and transferring each group to corresponding local memory devices coupled to the remote memory device (see Column 5, Lines 24-31 for transmitting the items to the subscribers local memory device 56 in Figure 2), wherein the audio-video data files are automatically selected and transferred from the data repository in accordance with a result of an analysis of profiles of each of the local memory devices (see Column 5, Lines 12-16 for using collaborative filtering techniques (which analyzes other users profiles to create a list of preferred programming for the user)), and wherein each group of files to be transferred to the corresponding local memory devices are selected according to the profile of the corresponding local memory device to which each group of files will be transferred (see again Column 5, Lines 15-16 for producing a list of recommended items for each subscriber based on all of the users profiles (using collaborative filtering)).

9. Referring to claim 2, Payton discloses that the profiles indicate previous file selections by users of the remote memory devices (see Column 5, Lines 7-10).

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims **3-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton (U.S. Patent No. 5,790,935) in view of Brodigan (U.S. Patent No. 6,530,086).
12. Referring to claim **3**, Payton discloses all of the limitations in claim 1, as well as at least one remote memory device (see central distribution server 24 in Figure 2 and Column 4, Lines 45-46), but fails to teach that the remote memory device is a central office storage device. Brodigan discloses that video can be transmitted to a user using a VDSL distribution network (see Column 2, Lines 5-9 and 31-32), which comprises a central office (see Column 2, Lines 11-15). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the distribution system of Payton, using the VDSL distribution system (with central office), as taught by Brodigan, for the purpose of advantageously providing a single platform for supporting bandwidth-intensive application (see Column 2, Lines 1-2 of Brodigan).
13. Claim **4** corresponds to claim 3, where Payton discloses that the central office (remote server 24 of Payton and central office 12 of Brodigan) comprises a hard disk (see Column 4, Lines 66-67 and Column 5, Line 1).
14. Referring to claim **5**, Payton discloses a local server at the customer's premise (see local server 28 in Figure 2), as well as a playback device (see Column 6, Lines 20-22), but fails to specifically teach a set-top box. Brodigan discloses the use of a set-top

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box to receive the video programs (see STB 34 in Figure 1). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the subscriber's premise, as taught by Payton, using the STB 34, as taught by Brodigan, for the purpose of providing two-way communication over a network (see Column 6, Lines 11-13 of Brodigan).

15. Claim 6 corresponds to claim 5, where Payton and Brodigan fail to teach that the STB can store the video programs locally. The examiner takes Official Notice that TiVo or ReplayTV devices are well known in the art to store programs along with a listing of the recorded programs (in the form of an EPG) and display these programs on a television. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the STB of Payton and Brodigan, using the TiVo or ReplayTV device, for the purpose of providing the consumer with a single integrated device (as opposed to a STB and separate VCR device) so that the consumer can use a single remote and save shelf space in his/her entertainment center.

16. Referring to claim 7, see the rejection of claim 5 for the addition of a set-top box. Also note that the remaining limitations read of the collaborative filtering technique of Payton for providing programs to a viewer, where all of the different viewer profiles are combined to determine a viewer's favorite programs to be transmitted to the viewer (see Column 5, Lines 6-21).

17. Referring to claim 8, see the rejection of claim 3 for a first memory at a central office and claim 6 for the STB having an integrated storage device. Also note Figure 1 of Brodigan, which shows that multiple STBs can be connected to the central office.

18. Claim 9 corresponds to claim 8, where Brodigan discloses that the STBs are coupled to the central office using DSL (see Column 1, Lines 57-60).

19. Referring to claim 10, see the rejection of claims 1-9 and also note that Brodigan further discloses a main facility (program host server 16) in Figure 1 for supplying portions of programs to the central office. Also note that Payton discloses using community interest profiles (using collaborative filtering) to provide portions of data to viewers.

20. Claim 11 corresponds to claim 10, where the central office and main storage facility are co-located (see Payton and Brodigan for the server/central office containing a main storage facility (repository 34 in Figure 2 of Payton and headend data server 18 in Figure 1 of Brodigan)). Also note that the program host server 16 in Figure 1 of Brodigan supplies programs to the central office 12, and is therefore "co-located". The examiner notes that the prefix "co" is defined as, "Together; joint; jointly; mutually", therefore, since the central office 12 and program host server 16 are coupled through the Internet 20, they are "together" and are therefore, co-located.

21. Claims 12 and 13 correspond to claim 10, where Payton discloses that a first portion of movies, are the result of the collaborative filtering process, where only a first set of items (which include movies) are transmitted to the viewer (see Column 5, Lines 6-21). Note that the second portion of data includes the overall storage of all the possible movies provided to the viewer (see Column 4, Lines 66-67 and Column 5, Line

22. Claims **14-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton (U.S. Patent No. 5,790,935) in view of Brodigan (U.S. Patent No. 6,530,086) in further view of Garfinkle (U.S. Patent No. 5,530,754).

23. Referring to claim **14**, Payton discloses receiving a request from a user to view a video (see Column 4, Lines 51-54). Payton also discloses determining if the requested video is stored on the user's local server (see Column 5, Lines 31-33). Payton also discloses initiating a download of the requested video to the user's local server if the requested video is not stored at the local server (see Column 5, Lines 33-39). Payton discloses a local server at the customer's premise (see local server 28 in Figure 2), as well as a playback device (see Column 6, Lines 20-22), but fails to specifically teach a set-top box. Brodigan discloses the use of a set-top box to receive the video programs (see STB 34 in Figure 1). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the subscriber's premise, as taught by Payton, using the STB 34, as taught by Brodigan, for the purpose of providing two-way communication over a network (see Column 6, Lines 11-13 of Brodigan). Payton and Brodigan fail to teach the remaining limitations in the claim, which deal with buffering and displaying the incoming video during a first and second time period. Garfinkle discloses prompting the user to input user information using an input device (see Column 4, Lines 50-52) and a video screen as an output device (see Column 3, Lines 20-22), wherein the time used to input or confirm user information comprises a first period of time (see Column 4, Lines 55-58 and Column 5, Lines 3-8 for selecting a movie for order). Garfinkle also discloses displaying initial information on the video

screen for a second period of time (see Column 4, Lines 66-67 and Column 5, Lines 1-3). Garfinkle also discloses at least partially buffering the requested video in the user's STB memory during the first and second periods of time (see Column 5, Lines 8-9 and steps 74-80 of Figure 5, which show that the program is downloading while displaying the trailer, therefore partially buffering the requested video ... during the first and second periods of time). Garfinkle also discloses displaying the selected video on the video screen while completing the download of the requested video (see step 75 in Figure 5). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the local and remote server storage system, as taught by Payton and Brodigan, using the buffering system of Garfinkle, for the purpose of eliminating the hiatus created by the time consumed in the downloading process (see Column 1, Lines 66-67 of Garfinkle).

24. Claim 15 corresponds to claim 14, where Garfinkle discloses that the initial information is a video trailer (see Column 4, Lines 43-44).

25. Claims 16 and 17 corresponds to claims 15 and 16, respectively, where Brodigan discloses the STB is coupled to the central office through a DSL and that the DSL connection is VDSL (see the rejection of claims 3 and 9).

26. Claim 18 corresponds to claim 14, where Payton, Brodigan and Garfinkle fail to teach a blank screen between different screens of information (prompting screen and initial information screen). The examiner takes Official Notice that it is well known in the art to display a blank screen between movies trailers and previews and that there are also blank screen between selecting information in an EPG and presenting the content

selected. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the VOD system, as taught by Payton, Brodigan and Garfinkle, using a blank screen between the user being prompted and the initial trailers, for the purpose of providing the user with less confusion one which part of the presentation is being displayed.


27. Claim 19 corresponds to claim 14, where Brodigan discloses downloading the requested video from a central office memory (see the rejection of claim 3).

28. Referring to claim 20, see the rejection of claims 10 and 13-14. Also note that Payton at Column 5, Lines 6-21, teaches the additional limitation of updating the user's preference in accordance with the request to view a video

Conclusion

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 571-272-7307. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ngoc Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


James J. Groody
Supervisory Patent Examiner
Art Unit 262-2615

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).